

REMARKS

I. STATUS OF THE CLAIMS

Claims 1 through 9 and 52 are pending. Claims 10 through 29 and 32 through 51 have been canceled. Claims 1 through 9 and 52 are rejected.

II. REJECTION UNDER § 102(b)

Claims 1 and 52 are rejected under 35 U.S.C. § 102(b), as anticipated by US 4,950,432 to Mehta *et al.* (“Mehta ‘432”). This rejection is respectfully traversed.

Applicants’ claim limitations are not process limitations excludable from consideration of the product claims. Limitation to an “aqueous/t-butanol solvent system,” as claimed, is clearly a cognizable limitation to a product-by-process claim.

Limitations denominated as “process” limitations are held not patentably distinguishing *only* in cases where the product is not patentably distinguishable. See, *Ex parte Edwards et al.* 231 USPQ 981 (POBAI 1986) citing *In re Thorpe*, 227 USPQ 964 (Fed.Cir. 1985). In contrast, the limitations at issue in the instant matter define a patentably distinguishable product.

Addressing two of the limitations, attention is respectfully drawn to their product defining function – defining the claimed product as manufactured:

- “facile-reconstitute” refers to a distinguishing characteristic of the product. The distinguishing *product* characteristic is the facility of reconstitution -- a physical property of the lyophilate *per se*. This characteristic is presented at Specification page 19, lines 16-20 and page 20, lines 21-23.

- “submicron-reconstitute” refers to a distinguishing characteristic of the product. The distinguishing *product* characteristic is the size of liposomes which appear upon reconstitution.

The differentiating aspect becomes manifest within a process – reconstitution – but this does not alter its presence in the product *per se*. This aspect is found at Specification page 8, lines 23 and 26, page 19, line 25 through page 20, line 21, and FIGS. 2 and 3.

Applicants respectfully submit that the Examiner improperly excludes such limitations on the basis that, in the Examiner's view, such limitations are process/use limitations not cognizable for apparatus claim definition. Applicants maintain that *In re Mattison and Swanson*, 184 U.S.P.Q. 484, 485 (CCPA 1975) is controlling.

Mehta '432 is not anticipating. Mehta '432 does not yield submicron liposomes, nor is it facile reconstitute, nor does it meet the definition of aqueous/t-butanol solvent-system defining the absence of trace organic solvents.

The rejection under Mehta '432 relies solely on the discounting of Applicants' claimed limitations as being process limitations not cognizable in a composition of matter claim. It is respectfully submitted that the claim limitations are properly considered and may not be ignored. Withdrawal of this rejection is respectfully requested.

As to Claim 52, dependent on Claim 1, the limitation of halogenated solvent-free is noted. Mehta '432 uses halogenated solvents (*e.g.*, Mehta '432, col. 5, lines 42-45, methylene chloride; col. 6, line 5-8, chloroform). Removal is by evaporation, (col. 6, lines 11-14). This does not yield the halogenated solvent-free lyophilate as defined by Applicants.

Mehta '432 does not anticipate either Claim 1 or Claim 52 with all limitations. Applicants submit that full consideration of the claims with all limitations fully distinguishes Applicants product from Mehta '432.

III. REJECTION UNDER § 102(e)

Claims 1, and 52 are rejected under 35 U.S.C. § 102(e), as anticipated by US 5,811,119 to Mehta *et al.* ("Mehta '119"). This rejection is respectfully traversed.

The rejection under Mehta '119, as with Mehta '432, is not supported when read in view of Applicants' claimed limitations as to either Claim 1 or Claim 52. Claim 1 is drawn to a

product of a specific solvent system solvent system process. Claims 1 and 52 further claim a product with distinct characteristics in the product *per se*. These distinguishing characteristics are manifested in (i) reconstitution behavior and in (ii) liposomal size upon reconstitution. These are defining characteristics of a product and not process limitations of the claimed product. As such, the limitations are cognizable in the present composition of matter claim.

Mehta '119 does not anticipate either Claim 1 or Claim 52 with all limitations. It is respectfully requested that this rejection be withdrawn.

IV. REJECTION UNDER § 103(a)

Claims 2 through 9 are rejected under 35 U.S.C. § 103(a), as obvious in view of either Mehta '432 or Mehta '119 as cited above and further in view of US 5,585,12 to Unger ("Unger"), US 5,089,602 to Isliker ("Isliker") and US 5,653,996 to Hsu ("Hsu") individually or in combination. This rejection is respectfully traversed.

As noted by the Examiner, the present rejection is based on disregarding Applicants' claim limitations deemed to be process limitations inapplicable to a composition of matter claim. Applicants' reiterate the argument presented above that the limitations are as to solvent system, reconstitution, and size upon reconstitution are cognizable in the present composition of matter claim, as supported by case law. In view of this, the present rejection is unsupported and respectfully submitted to be improper.

As noted by the Examiner, Mehta ['432 and '119] fails to disclose surfactants such as Tweens. Mehta '432 and '119 also fails to disclose the specific solvent system, the ease of reconstitution, and the submicron product upon reconstitution. None of Unger, Isliker, or Hsu supply these deficiencies.

Applicants note that the Examiner retains the rejection based on Islike and/or Hsu, presuming, *arguendo*, that Unger teaches away and may not be combined in the rejection. This position is respectfully submitted as fatally inconsistent with the Examiner's earlier arguments. The Examiner offers "stability" as the reason to combine references. (Office Action of October

10, 2000, page 6.) Stability, however, was offered by the Examiner as a teaching of Unger (Office Action of March 17, 1999). Thus, absent Unger, the remaining references – alone or in combination – are not properly combined to render the instant invention obvious.

Neither Isliker nor Hsu discloses the claimed solvent system – individually or in combination. Isliker does not teach or suggest the use of Tween or any other surfactant except as found within an intermediate processing step. Neither facile-reconstitute liposomes nor submicron liposomes are taught or suggested by Isliker. Nothing in Isliker supplies any deficiency of Mehta '432, Mehta '119. The present invention cannot be rendered obvious by this combination of references.

Hsu does not supply the deficiencies of either Mehta patent to the claimed sub-micron, facile-reconstitute preliposomal powder derived from an aqueous/t-butanol solvent system. Hsu suggests no more than that Tweens can be employed in liposomal preparation. Even if applied to the Mehta patents, no combination of Mehta '432 or Mehta '119 with either Isliker, or Hsu or both arrive at the claimed invention.

In specific, Claim 3 is drawn to a preliposomal lyophilate containing anionic, cationic or nonionic surfactant. Unger teaches away from such surfactants for imparting the claimed submicron liposome size and ease of reconstitution. Isliker fails to disclose detergent containing lyophilate. And Hsu offers is no more than a surfactant without solvent system or any reason to combine the necessary elements, and neither Mehta can provide for such deficiencies.

Claim 4, specifies nonionic surfactant, and Unger, Isliker or Hsu can no more provide these elements to Mehta '432 or Mehta '119 than they could to Claim 3.

Claim 5 which specifies Tween as the surfactant; Claim 6 which specifies Tween 20, and Claim 7, 8 and 9 offer particular amounts of surfactant. Unger teaches away from and is inconsistent with the claimed invention. Isliker and Hsu offer no amounts of the surfactant to provide the claimed invention.

None of the cited references alone or in combination render the instant invention obvious.

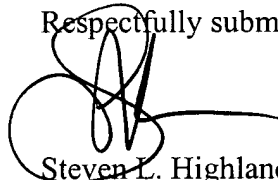
Combining these references is particularly addressed. In *Ruiz v. A.B. Chance Co.*, the CAFC has held (234 F.3d 654; 57 U.S.P.Q.2D1161 (2000) citing with favor *In re Dembiczak*, (175 F.3d at 999, 50 USPQ2d at 1617) as requiring the reasons one of ordinary skill in the art would have been motivated to select the references and to combine them to render the claimed invention obvious. ("Our case law makes clear that the best defense against the subtle but powerful attraction of a hindsight-based obviousness analysis is rigorous application of the requirement for a showing of the teaching or motivation to combine.")

As noted "stability" as the reason to combine references (Office Action of October 10, 2000, page 6) is not properly advanced given Unger represents at "teaching away." Thus, the combination as offered, alone or in combination cannot render the claimed invention obvious.

V. CONCLUSION

In light of the foregoing, applicants respectfully submit that all claims are in condition for allowance, and thus an early notification to that effect is solicited. Should Examiner Kishore have any questions regarding this application, a telephone call to the undersigned is invited..

Respectfully submitted,



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Date: July 13, 2001